



Remarks

1. Summary of Office Action

In the office action mailed January 25, 2005, the Examiner rejected claims 1-4 and 6-10 under 35 U.S.C. § 102 (e) as being anticipated by Tiedemann (U.S. Patent No. 6,246,673). The Examiner also objected to the abstract.

2. Examiner Objections

In response to the Objection of the abstract by Examiner, the abstract has been revised.

3. Amendments to the Claims

Applicant has amended claims 1 and 7-8 and cancelled claim 6. Claim 1 has been amended to incorporate the language of claim 6, and in particular, to recite that the long code state information is included in the handover message. Thus, the long code state information is provided to a mobile station. Claim 7 and 8 have been amended so that they depend on claim 1. No new material has been claimed.

4. Response to the 35 U.S.C. § 102 Claim Rejections

The Examiner rejected claims 1-4 and 6-10 under 35 U.S.C. § 102 (e) as being anticipated by Tiedemann (U.S. Patent No. 6,246,673). In order to anticipate a claim, a reference must teach every claim element. (MPEP § 2131). Applicants submit that Tiedemann does not teach every element of claim 1.

Tiedemann discloses a method of performing a handoff of a mobile station from an asynchronous base station to a synchronous base station. (Tiedemann, Col. 14 lines 43-50). Included in this method is the step of an asynchronous base station sending a neighbor list of synchronous base stations to a mobile station. (Tiedemann, Col. 16 lines 63-68). The mobile station connects to a synchronous base station by performing a search within a search window on the list of synchronous base stations. (Tiedemann, Col. 17 lines 4-6). If a pilot signal of a synchronous base

station is found, the mobile station is handed off to the synchronous base station. If a pilot signal is not found, a longer pilot code search is performed and a handoff is attempted when a pilot signal is found. (Tiedemann, Col. 17 lines 15-23). Or, if the pilot signal cannot be found a method for unambiguously synching system time is disclosed and a handoff can be performed. (Tiedemann, Col. 17 lines 28-31).

Although Tiedemann discloses a method of performing a handoff between an asynchronous system and a synchronous system, Tiedemann does not disclose Applicants' claimed method for transmitting information about a synchronous system to a mobile station in an asynchronous mobile communication system.

Applicants' method receives at an asynchronous radio network "handover-related information from a plurality of neighboring synchronous systems." (Claim 1 and Specification, page 22 lines 11-15). Thus, Applicant's method utilizes handover information received via communication from a synchronous base station to an asynchronous base station. This feature allows an asynchronous system to determine which synchronous system is in a best state for a handover. (Specification, page 22 line 27 to page 23 line 2). In comparison, Tiedemann's disclosed method is quite different. Tiedemann sends a list of neighbor synchronous stations from an asynchronous station to a mobile station. Nowhere in the disclosure of Tiedemann does an asynchronous base station receive handover information (or neighbor information) from a synchronous station.

In addition, Tiedemann does not teach another claim element recited in claim 1, namely, that "the inter-system handover message is transmitted to the mobile station by inserting the long code state information into a first subfield within an inter-system message included in the inter-system handover message in order to provide the mobile station with the long code state information." (Specification, page 23 lines 22-26). In Applicants' method, long code state information is contained within the communication between the

asynchronous system and the mobile station. In contrast, Tiedemann discloses using an ID channel that contains a 9-bit pilot PN offset, 2-bit phase of the pilot PN sequence and/or 1-bit even odd indicator to determine the PN long code state. (Tiedemann, Col. 18 lines 32-40). Thus, Tiedemann teaches that the mobile station will receive this information, and use this information to calculate state information. Tiedemann necessitates additional processing by the mobile station using the received information to determine a long code state.

In contrast, Applicants' method includes sending the state information directly to the mobile station, which uses activation time information to determine when to use the long code state information. (Specification, page 25 lines 17-23). Because the state has already been determined before transmission to the mobile station, the mobile station does not need to calculate state information.

Applicants submit that since Tiedemann does not teach all of the claim elements of pending claim 1, Tiedemann does not anticipate claims 1-4 and 7-10.

5. Conclusion

For the reasons set forth above, Applicants submit that claims 1-4 and 7-10 are in condition for allowance and respectfully request the Examiner to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of this application, the Examiner is invited to call the undersigned representative at 312-913-3331.

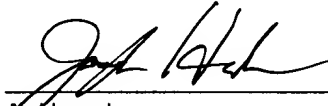
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Respectfully submitted,

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